



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,481	08/01/2001	Dawn Carey	U000-P02020US	5566

33356 7590 12/26/2006
SoCAL IP LAW GROUP LLP
310 N. WESTLAKE BLVD. STE 120
WESTLAKE VILLAGE, CA 91362

EXAMINER

OSBORNE, LUKE R

ART UNIT	PAPER NUMBER
----------	--------------

2123

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	12/26/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED

DEC 26 2006

Technology Center 2100

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/920,481
Filing Date: August 01, 2001
Appellant(s): CAREY, DAWN

Joel G. Landau (54,732)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/28/2006 appealing from the Office action mailed 6/19/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5724424	Gifford	3-1998
5,903,878	Talati	5-1999

2003/0028448 Joseph 9-2002

6,351,524 Schuster 2-2002

Applicant admitted prior art at the Specification paragraph [0004]

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-2, 4-6, 13-14, 16-18, 22-23, 25-27, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gifford (5,724,424) of record in view of Talati (5,903,878).

Regarding claim 1, Gifford teaches a method of delivering items of content from a storage location to client devices at remote locations through e-mail based inquiry-response automation. See Figures 1, 6, 7, 14, 16 and the corresponding portions of Gifford's specification for this disclosure. In particular, Gifford teaches A method of delivering items of content from a storage location [Figure 1, item 65] to client devices at remote locations [Figure 1] through an e-mail based inquiry-response automation, the method comprising the steps of

- Providing a content delivery system for customer support

- storing plural items of content, wherein the plural items of content are technical support information [Figure 1, item 65, Figure 2, Column 4, lines 43-51]
- storing respective descriptions of the items of content and respective order codes for the items of content [Figure 1, item 65, Figure 2, Column 4, lines 52-55]
- receiving a first message via e-mail [system can implement an electronic mail order system (Column 7, lines 9-10)] from a user of a given client device at a remote location, whereby an inquiry-response transaction is initiated [Figure 6, items 19-20]
- responding via e-mail to the first e-mail message with a prompt message item, the prompt e-mail message including an arrangement of descriptions and order codes for a plurality of the items of content and instructions to the user for ordering the items of content [Figure 6, item 22, 23, 24, Column 5, lines 18-28]
- parsing the second e-mail message for at least one of the order codes specified by the user [Figure 6, item 25]
- extracting the items of content identified by the order codes in the second e-mail message [Figure 6, item 30]
- packaging the items of content from the extracting step into a single package unit [Figure 6, item 30]
- responding via e-mail to the second e-mail message with a response e-mail message comprising the single package unit comprising the items of content corresponding to the order in the second e-mail message [Figure 6, item 31].

Art Unit: 2123

Gifford does not expressly teach assigning a tracking code for the e-mail based inquiry-response transaction or parsing the second e-mail message and identifying the tracking code in the second e-mail message.

Talati discloses a method similar to Gifford providing for an online system for electronic commerce. See Figures 1 and 2 and the corresponding portions of Talati's specification for this disclosure. In particular, Talati uses a Unique Global Transaction ID (UTID) in order to help identify the originator (user) [Column 4, lines 49-51, Figure 12, item 331]. Talati also teaches "the use of the UTID in all communications" Talati Column 6, lines 44-52.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the UTID tracking code of Talati with the online transaction system of Gifford.

The motivation for doing so would have been to reduce fraudulent transactions as evidenced by Talati Column 6, lines 44-52.

Regarding claim 2, Gifford in view of Talati teaches the method of delivering items of content from a storage location to client devices at remote locations through e-mail based inquiry-response automation of claim 1. In particular, the combination teaches further comprising, after the step of parsing the second e-mail message for at least one of the order codes, if the second e-mail message does not have at least one order code specified by the user [Gifford: Figure 7, item 33], then responding via e-mail to the second e-mail message with a simpler prompt message [Gifford: Figure 7, item

34], the simpler prompt e-mail message including the arrangement of descriptions and order codes for a plurality of the items of content, the tracking code, and simpler instructions to the user for ordering the items of content [Gifford: Column 7, lines 30-49].

Regarding claim 4, Gifford in view of Talati teaches the method of delivering items of content from a storage location to client devices at remote locations through e-mail based inquiry-response automation of claim 1. In particular, wherein the response e-mail message includes the tracking code [Talati: Column 6, lines 44-52].

Regarding claims 5 and 6, Gifford in view of Talati teaches the method of delivering items of content from a storage location to client devices at remote locations through e-mail based inquiry-response automation of claim 1.

The combination as applied to claim 1 does not teach storing the first and second e-mails. However, Talati further teaches storing the first e-mail and second e-mail messages as shown in Talati: Figure 11, item 315 and 330.

At the time of the invention it would have been obvious to one of ordinary skill in the art, to use the e-mail database of Talati with the e-commerce system of Gifford.

The motivation for doing so would have been to keep a record of the transactions and to determine the format of the email as evidenced by Talati Column 8, lines 47-61.

Claims 13-14, 16-18, and 22-23, 25-27 refer to the system for method claims 1-6 thus are rejected for the same reasons as claims 1-2, 4-6.

Claim 41 refers to the method of claims 1, thus is rejected for the same reasons as claim 1.

2. Claims 3, 15 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gifford of record in view of Talati of record, further in view of Applicant Admitted Prior Art (AAPA) at paragraph [0004].

Regarding claim 3, Gifford in view of Talati in view of AAPA teaches the method of delivering items of content from a storage location to client devices at remote locations through e-mail based inquiry-response automation of claim 2. In particular, further comprising receiving a third message via e-mail from the user [Gifford : Figure 6, item 21] parsing the third e-mail message and identifying the tracking code in the third e-mail message [Talati Column 6, lines 44-52] parsing the third e-mail message for at least one of the order codes specified by the user if the third e-mail message has at least one order code specified by the user, then extracting the items of content identified by the order codes in the second e-mail message packaging the items of content from the extracting step into a single package unit responding via e-mail to the second e-mail message with a response e-mail message comprising the single package unit comprising the items of content corresponding to the order codes in the second e-mail message [Gifford: Figure 6,7].

Gifford in view of Talati does not teach if the third e-mail message does not have at least one order code specified by the user, then referring the third e-mail message to a human specialist at a client device.

However as applicant's admits in paragraph [0004] that "In the past, telephone operators and support staff have typically been required to retrieve the information requests."

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, in combination with applicant's knowledge of the art to, refer to a human specialist when the automation of the process reached an impasse, i.e. if the third e-mail message does not have at least one order code specified by the user.

The suggestion for doing so would have been to make the process faster, and more efficient, and cost less, as Applicant suggests in paragraph [0004]

Claims 15, 24 refer to the system for method claim 3 thus, are rejected for the same reasons as claim 3.

3. Claims 7, 19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gifford in view of Talati of record, further in view of U.S. Pre Grant Publication No. 2003/0028448 to Joseph et al. hereinafter "Joseph".

Regarding claim 7, Gifford in view of Talati teaches the method of delivering items of content from a storage location to client devices at remote locations through e-mail based inquiry-response automation of claim 1. Gifford's transactions are for information documents.

The combination does not teach that the items of content comprise technical support documents the descriptions of the items of content comprise common technical support questions which are answered by the respective technical support documents.

Joseph teaches an automated customer support system using email see figure 1. This system takes an email of common technical support questions and sends back answers from the respective technical support documents see paragraph 0012.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to use the automated system as disclosed by Joseph with the combination as described for claim 1.

The motivation for doing so would have been to automate the expensive strictly manual support process as found in paragraph 0002.

Applicant's arguments with respect to claim 7 have been considered but are moot in view of the new ground(s) of rejection.

Claims 19, 28 refer to the system for method claim 7 thus, are rejected for the same reasons as claims 7.

4. Claims 8 – 12, 20-21 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gifford in view of Talati of record as applied to claim 1 above, and further in view of Schuster of record.

Claims 8 and 9 are directed to assigning status codes to the e-mail for tracking purposes. The combination of Gifford in view of Talati as applied to claim 1 does not expressly teach such status codes.

Schuster teaches using status codes with e-mail [Schuster: STATUS CODE 350].

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to combine the status codes of Schuster with the e-mail ecommerce combination as applied to claim 1.

The motivation for doing so would have been to be able to track the progress of the transaction to be able to pick up at the right place if need be if there were a problem in the system (ie power failure) such motivation is common in the art.

Claims 10 –12 are directed to restricting and restraining access by the users to the items of content in accordance with specified criteria. This criteria being the client's device being able to accept such content, and whether or not the user has chosen to be able to receive such content. The combination of Gifford in view of Talati as applied to claim 1 does not expressly teach such restrictions of access.

Schuster teaches content restriction according to the user's preferences [each dial-up user has a profile (Column 6, lines 43-44)] and the users device [accesses user profile database (UPD) 330 to determine if the originating communication device is recognized as being associated with a user account serviced by the remote access system (Column 7, lines 30-33)].

At the time of the Applicant's invention, it would have been obvious to a person of ordinary skill in the art to use the user profile containing user and device information of Schuster to the e-mail ecommerce combination as applied to claim 1.

The motivation for doing so would have been to only provide content that the device could handle (ie not sending a sound to a device without a speaker), or sending data that the user doesn't want.

Claims 20-21, 29-30 refer to the system for method claims 8-9 thus are rejected for the same reasons as claims 8-9.

(10) Response to Argument

The Examiner finds Appellant's arguments unpersuasive. In particular, regarding the argument that Gifford does not teach the limitation from claim 1 "receiving a first message via e-mail from a user of a given client device at a remote location, whereby an inquiry-response transaction is initiated" the Examiner notes that transactions are initiated as cited by Appellant's in the instant Brief on page 7 first partial paragraph that "This is the only embodiment in which Gifford discloses, teaches or suggests initiating a transaction." The Examiner agrees with Appellant's that there is an embodiment that teaches initiating a transaction.

Regarding the argument that Gifford does not disclose, teach or suggest the initiation of a transaction via **e-mail** the Examiner finds this argument unpersuasive. The Examiner notes that there is a suggestion if not a teaching of the use of e-mail in Gifford present at column 7, lines 3-10, as stated by Gifford "In this way the network sales

system can implement an electronic mail order system" (emphasis added). Moreover, the Examiner has not afforded the term "e-mail" as used by Appellant's a special definition as a term of art. The term e-mail as used in the specification has not been given a meaning outside the generic usage of the term. Appellant's Specification Paragraph [0021] states what system can be used to e-mail, but is silent in the remainder of the disclosure on any particular definition for said term.

The client device 100 **preferably comprises** a client computer that is configured to send e-mail messages to and receive e-mail messages from the network 120. The client device 100 **may be**, for example, a PC running a Microsoft Windows operating system and an e-mail client such as Microsoft Outlook, Qualcomm Eudora, or Netscape Communicator. The client device 100 **may also be**, for example, a network appliance, personal digital assistant (PDA), mobile phone, refrigerator or another server. (emphasis added)

The term e-mail while common in its usage does not have a particularly specific ordinary definition. As such, the Examiner does not find reason to hold the term "e-mail" as recited in claim 1 and the HTTP request patentably distinct. The following is an example from the Oxford Online dictionary.

email¹

- noun the sending of messages by electronic means from one computer user to one or more recipients via a network.
- verb mail or send using email.

Gifford then indeed teaches such an "e-mail" message through electronic means as Applicant's acknowledge in the analysis of the Gifford reference.

¹ http://www.askoxford.com/concise_oed/email?view=uk

Appellant's provide a supposed contradictory definition of "e-mail" along with a definition of the term "hyperlink" in the instant Brief Page 8, from the Microsoft Computer Dictionary. The definition for *e-mail*: short for electronic mail and the exchange of text messages and computer files over a computer network... The examiner does not see any supposed distinction even from this definition and the chosen definition for "hyperlink". The plain and literal meaning of a hyperlink and a Http request (as used in Gifford) to one of ordinary skill in the art at the time of Appellant's invention is that the hyperlink is text, and it is exchanged between computers on a network.

The arbitrary distinction that Appellant's are trying to impose upon the plain meaning of the claimed terminology is unsupported by the specification and the general usage in the art, it is for these reasons established above that Appellant's arguments are unpersuasive.

The remainder of Applicant's arguments are directed to the substance of the argument for claim 1, and have been found unpersuasive for the same reasons.

(11) Related Proceeding(s) Appendix


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

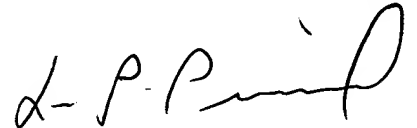
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Luke Osborne 12/15/2006

Conferees:


PAUL RODRIGUEZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100
12/14/06



LEO PICARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Leo Picard

Paul Rodriguez

